

REMARKS

Claims 17-30, 32, 33, 35, 37-40, 45-53, 56-60 and 64-67 are pending in the present application. Claims 56-60, 64, and 65 were previously withdrawn from consideration as drawn to a non-elected invention. No claims have been amended, cancelled, or added by virtue of this response.

In response to an election of species requirement, Applicants previously elected species A (target polynucleotide is DNA), species D (first and second primers are different), species E (propromoter oligonucleotide is a TSO), and species H (RNA-dependent DNA polymerase and enzyme that cleaves RNA from an RNA/DNA hybrid are the same enzyme) for searching purposes. Applicants respectfully request the Examiner to consider claims to additional species upon allowance of a generic claim as provided by 37 C.F.R. §1.141.

Information Disclosure Statement

The Examiner did not consider references 34-73 presented in the first four pages of the Form PTO-1449 provided with the Information Disclosure Statement or references 3 and 4 from the last page of the Form PTO-1449 provided with the Information Disclosure Statement. In the Office Action, the Examiner indicated that the reason these references were not considered is that copies were not provided.

Applicants respectfully note that the Information Disclosure Statement filed on October 14, 2003 specifically states that copies of listed documents were previously submitted in an Information Disclosure Statement and/or Office Action in related Application No. 09/893,191 (the parent of the present case) and accordingly, copies have not been provided. This protocol conforms with 37 C.F.R. §1.98(d) and MPEP §609(A)(2). Applicants respectfully request the Examiner to consider these references, which were submitted in the parent application, and to initial the Form 1449, indicating that they have been considered and made of record in this application.

Specification

The specification is objected to on the basis that the first paragraph has not been amended to provide updated cross-reference information. The specification has been so amended herein, rendering the objection moot.

Sequence Rules Compliance

The Office Action states that the specification must be amended to identify nucleic acid sequences with sequence identification numbers corresponding to those provided in the Sequence Listing. The specification has been so amended herein, thereby complying with the Sequence Rules.

Double Patenting

Claims 17-21, 24, 26, 28, 33, 38-40, 45, 66 and 67 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 2, 6, 11, 20, 27, 30, 92 and 108 over U.S. Patent No. 6,251,639, in view of Kacian et al. (U.S. Patent No. 5,480,784).

Solely to expedite prosecution and without acquiescence to the rejection, a terminal disclaimer over U.S. Patent No. 6,251,639 is filed herewith, thereby obviating this rejection.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

Claims 17, 30 and 46-53 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over of U.S. Patent No. 6,251,639, in view of Kacian et al. (U.S. Patent No. 5,480,784) and Lockhart et al. (U.S. Patent No. 6,040,138).

Solely to expedite prosecution and without acquiescence to the rejection, a terminal disclaimer over U.S. Patent No. 6,251,639 is filed herewith, thereby obviating this rejection.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 492962000610. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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